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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,998	03/11/2004	Stanislav M. Snaird	000417.00019	4647
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BANNER & WITCOFF, LTD.			EXAMINER	
1100 13th STREET, N.W.			LOPEZ, CARLOS N	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,998	Applicant(s) SNAIDR ET AL.
	Examiner CARLOS LOPEZ	Art Unit 1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 April 2009.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 10 and 11 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 10 and 11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/06/08)
 Paper No(s)/Mail Date 3/16/09
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 and 11 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Valdez (US 4,685,477). Valdez discloses cigar or cigarette holder capable of receiving a cigar or cigarette and for filtering smoke generated from the cigar or cigarette. The holder has three chambers. The first chamber defined by the space between a perforated tubular member, concentrically situated around a perforated inner tubular member, and the inner tubular member. The first chamber is substantially filled with a filter material. The second and third chambers are within the inner tubular member, substantially

coaxially aligned and separated by a wall having an aperture to transfer ash from the second chamber to the third chamber. The claimed non-combustible tubular member is deemed as element 25, which as noted in Col. 3, lines 10 made be made of porcelain, a known ceramic, which is non-combustible. Element 25 as shown in figure 3 encases the tobacco charge which is deemed as the tobacco rod 14. In regards to claim 11, the perforation 26 provide for the claimed porosity.

As noted by Valdez, the plurality of air intake spaces, perforations 26, is useful for enabling the ember end of the cigar or cigarette to burn. As the smoker puffs or draws on the primary smoke filter end of the cigar or cigarette, air may be drawn into the second and third chambers through the air intake spaces to enable the ember to burn. In this manner, sufficient air is provided for burning of the tobacco to generate smoke. Valdez teaches that varying the size and/or number of the air intake spaces to control the rate at which the ember end of the cigar or cigarette burns is possible. In this manner, the cigar or cigarette may be made to burn slower and therefore last longer than if smoked without the use of Valdez device. Thus the perforations 26, as noted by Valdez, reduces the free-burning rate of the burning tobacco in order to increase the number of puffs from the burning tobacco charge as instantly claimed by applicant.

In view that the tubular member 25 has a certain porosity as determined by the size and number of perforations 26, the sidestream smoke is minimized when compared to a cigarette not enclosed by the tubular member 25 of Valdez.

Moreover, in view that the Valdez provides the claimed structural limitations as recited in device claims 10 and 11, it would be obvious to a person of ordinary skill in the art as noted above to have met the claimed functions.

Alternatively, Valdez inherently provides the claimed features recited in claims 10-11 by encapsulating a cigarette with glass material having a specified number of perforations and perforation size. The encapsulation of the cigarette inherently minimizes the amount of sidestream smoke and at the same time reduce the free burn rate of the cigarette, due to less air being supplied to the burning cigarette, in order to increase the number of puffs from the burning tobacco charge as instantly claimed.

Claim 10 and 11 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 06-052497 ('497). '497 discloses cigar or cigarette holder capable of receiving a cigar or cigarette. The holder comprises a glass stowage element 2, deemed to be a ceramic material¹, which encases an effective amount of tobacco charge as shown in figures 1 and 2. The storage ceramic element comprises of fine pores 8, thus allowing for the reduction of the claimed side-stream smoke and restricting the inflow of air to thus reduce the free-burn rate of the burning tobacco.

In view that the tubular member 2 has a porosity as determined by the size and number of pores 8, the sidestream smoke is minimized when compared to a cigarette not enclosed by the tubular member of '497. Moreover, in view that the '497 provides

the claimed structural limitations as recited in device claims 10 and 11, it would be obvious to a person of ordinary skill in the art as noted above to have met the claimed functions.

Alternatively, '497 inherently provides the claimed features recited in claims 10-11 by encapsulating a cigarette with glass material having a specified number of perforations and perforation size. The encapsulation of the cigarette inherently minimizes the amount of sidestream smoke while reducing the free burn rate of the cigarette due to less air being supplied to the burning cigarette.

Response to Arguments

Applicant's arguments filed 6/30/09 have been fully considered but they are not persuasive.

Applicant makes the argument that Examiner's assertion that element 26 of Valdez enables the ember end of the cigarette to burn is erroneous because air is drawn from intake air element 22 and not element 26.

As noted above, the tubular member 25 has a porosity as determined by the size and number of perforations 26, the side-stream smoke is minimized when compared to a cigarette not enclosed by the tubular member 25 of Valdez. To further expand on this statement, if a cigarette is enclosed by a tubular element having a specific porosity, the cigarette's side-stream smoke is reduced (when compared to a cigarette that is not enclosed by a tubular element of Valdez) because one now has obstructions/holes that

¹ The term ceramic is a generic term encompassing materials such as glass, enamel, concrete, cement, pottery, brick, porcelain, and chinaware.

prevent the free release of side-stream smoke; especially when these pores are adjacent to filter material filtering side-stream smoke as in Valdez. Additionally, because less air is reaching the ember due to cigarette being enclosed in a chamber, less air will reach the ember which would cause the ember to burn at a lower temperature resulting in a reduced free-burn rate when compared to a cigarette that is not enclosed by the Valdez chamber. Hence, applicant's argument that Valdez does not meet the functional limitations is found unpersuasive because Valdez's device is capable of functioning as intended by applicant.

Similarly the arguments presented against the JP '497 are unpersuasive. Applicant argues that JP does not minimize side-stream but admits that JP reference "removes only two components in side-stream smoke." If it removes components of side-stream it follows that it is "reducing" side-stream smoke as required by the claimed invention.

Applicant also argues that the fine pores 8 of JP 497 do not reduce the free-burn rate because JP 497 provides venting holes all over the surface of the encasing to ensure that the cigarette will stay lit when the cigarette is not smoked. Applicant then states that JP 497 does not discuss a reduced free burn rate at all. However, said argument is unpersuasive.

Ensuring that the cigarette will stay lit when enclosed in the chamber is not a reasonable basis to show that the free-burn rate will not be reduced. It is reasonable to assume that applicant, like Valdez and JP 497 all ensure that the cigarette will be maintained lit because it would be useless for a person of ordinary skill in the art to

make and use a cigarette holder that would extinguish a cigarette when in use. In view that the claim only requires a tubular element having a predetermined number of pores, as in the claimed invention, it is reasonable to conclude that the cigarette in the JP 497 tubular element would have a reduced free-burn rate when compared to a cigarette not placed in the tubular element of JP 497 because JP '497's tubular element would obstruct the free flow of air reaching the burning cigarette. Consequently, less air reaching the cigarette (when compared to the air present for a cigarette not enclosed by a tubular element) would reduce the free burn rate of the cigarette.

Thus, while it is true that JP 497 does not discuss the free-burn rate at all, a person of ordinary skill in the art readily recognizes that the obstruction of the air flow reaching the cigarette would provide a device that is capable of providing less air to the burning cigarette that would cause the free-burn rate to be reduced when compared to a cigarette having no obstruction.

As previously noted, the MPEP 2114 notes the following:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

"Apparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)."

Applicant has not provided any structural differences between Valdez and Applicant's claimed invention. Applicant again incorrectly emphasizes distinction by function and/or intended use of the claimed device when in fact applicant should be distinguishing the claimed invention by structural features.

Applicant states that "the properties and characteristics of the claimed structure are different from those of the cited documents as the documents themselves illustrate." However, the claim only structurally defines a tubular element with pores which are provided by JP 497 and Valdez. If the applicant considers that the intended use limitations recited in the pending claims do provide distinguishable structures from the prior art, Examiner invites applicant to define what the structures are.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLOS LOPEZ whose telephone number is (571)272-1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos Lopez/
Primary Examiner
Art Unit 1791